

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHAN J.W. PLATZER

Appeal No. 1997-3334
Application No. 08/456,588

ON BRIEF

Before JOHN D. SMITH, WALTZ and JEFFREY T. SMITH,
Administrative Patent Judges.

WALTZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 21 through 42, which are the only claims remaining in this application.

According to appellant, the invention is directed to a method for producing a positive image on a single sheet by modifying paper stock with a high peel strength adhesive, followed by use of an adhesive transfer article to produce an adhesive layer adjacent to the high peel strength layer, and

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laminating the photosensitive article to this adhesive layer (Brief, pages 4-6). A copy of illustrative independent claim 21 is attached as an Appendix to this decision.

The examiner has relied upon the following reference as evidence of obviousness:

Platzer et al. (Platzer '120) 4,910,120 Mar. 20,
1990

Claims 21 through 42 stand rejected under 35 U.S.C. § 103 as unpatentable over Platzer '120 (Answer, page 3). We reverse this rejection essentially for the reasons advanced by appellant on pages 7-13 of the Brief and pages 1-5 of the Reply Brief.¹ We add the following comments for emphasis and completeness.

OPINION

¹ We have considered the related appeal and decision in parent Application No. 07/894,168, Appeal No. 95-0473, decision mailed Sep. 30, 1997, Paper No. 31 (see the Brief, Page 3, item II, although appellant mistakenly lists the application no. as "08/894,168"). We note that the claims on appeal in parent Application No. 07/894,168 did not involve the adhesive transfer article recited in the claims in this appeal. The claimed subject matter on appeal in this application was the subject of a restriction requirement in grandparent Application No. 07/544,559 (now abandoned, see Paper No. 3 dated Mar. 1, 1991).

The examiner finds that Platzer '120 describes, teaches and suggests "each of the essential requirements of the instant invention as claimed *except* for teaching that the adhesive transfer article (comprising a substrate having a release surface on the substrate) is laminated" via the adhesive layer to the high peel strength adhesive layer on the receiver sheet (Answer, page 3, emphasis added). Appellant agrees that "[t]he present claims require the use of an adhesive transfer article which is absent from Platzer '120," also noting that the present invention requires three laminations as opposed to the two laminations required by Platzer '120 (Brief, page 10; see also the Reply Brief, page 3).

Although the examiner recognizes the deficiency in the disclosure and teachings of Platzer '120, the examiner concludes that "the same final product is being obtained" and it would have been *prima facie* obvious to laminate the second adhesive layer of Platzer '120 onto the high peel strength adhesive layer with subsequent lamination of the photosensitive article since the choice of lamination to the

photosensitive article or the high peel strength adhesive layer "is a mere matter of design choice" (Answer, paragraph bridging pages 4-5). The examiner further concludes that, based on the teachings of Platzter '120 and "the ability of the skilled artisan to modify well known process manipulation steps," it would have been *prima facie* obvious to obtain the claimed process "with a reasonable expectation of achieving the same or similar results" as Platzter '120 (Answer, page 5).

Appellant argues that there is no suggestion in Platzter '120 of laminating the adhesive layer to the high peel strength adhesive containing receiver sheet rather than to the photosensitive layer (Brief, page 12). Appellant submits that the mere fact that a reference can be modified does not render an invention obvious if the prior art does not also suggest the desirability of such a modification (Reply Brief, page 2). We agree.

The initial burden of establishing a *prima facie* case of obviousness rests with the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In the appropriate circumstances, a single prior art reference can

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render a claim obvious. *See, e.g., B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). "When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. [Citation omitted]." *B.F. Goodrich Co., supra*; *see also In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997)(When relying on a modification of the prior art, it is incumbent upon the examiner to identify some suggestion to make the modification). A "reasonable expectation of success" is not the sole consideration in a section 103 analysis but whether the prior art would have suggested the proposed modification must also be considered. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

We determine that the examiner has not satisfied the initial burden of establishing a case of *prima facie* obviousness. The examiner has not identified any teaching, suggestion or motivation for modifying the Platzzer '120

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reference in the manner proposed in the examiner's rejection. The identity of the final product is not particularly relevant to the method claims on appeal (see the Answer, page 4). Characterizing the difference between the claimed subject matter and the disclosure of Platzer '120 as a "mere matter of design choice" (Answer, page 5) does not meet the examiner's initial burden unless the examiner sets forth convincing reasoning and/or evidence that such "design choices" would have been well known in the art, i.e., a showing that it was well known in the art to have a photosensitive layer without any adhesive layer protecting it and it was well known in the art to have another adhesive layer laminated to the high peel strength adhesive layer. The examiner has not presented any such showing on this record.

For the foregoing reasons and those set forth in the Brief and Reply Brief, we determine that the examiner has not established a *prima facie* case of obviousness. Accordingly, the examiner's rejection of claims 21 through 42 under 35 U.S.C.

§ 103 as unpatentable over Platzer '120 is reversed.

The decision of the examiner is reversed.

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REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
THOMAS A. WALTZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY T. SMITH)	
Administrative Patent Judge)	

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APPENDIX

21. A method for producing a positive image on a single sheet which comprises, in order:

- a) providing a receiver sheet; and
- b) providing a high peel strength adhesive article, said high peel strength adhesive article comprising a substrate having a release surface and a high peel strength adhesive layer on said release surface, which high peel strength adhesive layer comprises a thermoplastic resin or resins having a peel strength of greater than 100 g/inch when adhered to said receiver sheet;
- and
- c) laminating said high peel strength adhesive layer to the receiver sheet with pressure at a temperature in the range of from about 60°C to about 120°C; and
- d) peeling apart said substrate and receiver sheet, thereby transferring the high peel strength adhesive layer to the receiver sheet; and
- e) providing an adhesive transfer article comprising a substrate having a release surface and an adhesive layer on said release surface, which adhesive layer comprises a thermoplastic resin or resins; and
- f) laminating said adhesive transfer article via the adhesive layer to the high peel strength adhesive layer on the receiver sheet with pressure at a temperature in the range of from about 60°C to about 120°C; and
- g) peeling apart the substrate and the receiver sheet, thereby transferring the adhesive layer from the substrate to the high peel strength adhesive layer on the receiver sheet; and

- h) providing a photosensitive article which comprises a transparent support and a photosensitive composition layer on said support, said photosensitive composition comprising an organic binding resin, a colorant, a photoinitiator, and a free radical polymerizable acrylate or methacrylate component having at least two ethylenically unsaturated groups; wherein the binding resin is present in sufficient amount to bind the composition components into a uniform film; wherein the colorant is present in sufficient amount to uniformly color the composition: wherein the photoinitiator is present in sufficient amount to initiate the free radical polymerization of the polymerizable component upon exposure to sufficient actinic radiation; and wherein the polymerizable component is present in sufficient amount to provide an image differentiation when the composition is exposed to actinic radiation; and
- i) either
- i) laminating the photosensitive composition layer to the adhesive layer on the receiver sheet and thereafter imagewise exposing the photosensitive composition layer to sufficient actinic radiation to provide an image differentiation; or
 - ii) imagewise exposing the photosensitive composition layer to sufficient-actinic radiation to provide an image differentiation and thereafter laminating the photosensitive composition layer to the adhesive layer on the receiver sheet; and thereafter
- j) peeling apart the transparent support and the receiver sheet such that the imagewise nonexposed portions of the photosensitive

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composition are transferred to the adhesive layer on the receiver sheet, thereby producing a positive image on the receiver sheet, while the imagewise exposed portions remain on the transparent support.

